

## KIRKLAND & ELLIS LLP

AND AFFILIATED PARTNERSHIPS

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May 22, 2020

**Filed via ECF**

THE HONORABLE LORETTA A. PRESKA  
United States District Judge  
Southern District of New York  
United States Courthouse, Courtroom 12A  
500 Pearl Street  
New York, NY 10007-1312

Letter-Motion for  
Pre-Motion Discovery Conference  
Local Civil Rule 37.2

**Re: Berall v. Verathon, Inc. et al., C.A. No. 1:10-cv-05777-LAP-DCF**

Dear Judge Preska:

Pursuant to Your Honor's Individual Practices and April 30, 2020 Order (D.I. 156), we write on behalf of Dr. Jonathan Berall to request a Pre-Motion Discovery Conference in the above-named patent case regarding certain mediation-related disputes. In accordance with your Order, we have met and conferred with counsel for each Defendant, and, as to the Verathon Inc. ("Verathon") dispute outlined below, sought assistance of the mediator regarding disclosures we believe are necessary for a fruitful mediation. We have been unable to come to a meeting of the minds on two issues, and request an informal conference with the Court.

*First*, LMA North America, Inc. ("LMA") has sought disclosure of the settlement agreements between Dr. Berall and certain former Defendants in this matter. At least one agreement contains confidentiality provisions requiring Dr. Berall to obtain permission from the other party to the agreement before disclosure. That party has requested that prior to disclosure, we obtain a Protective Order in order to ensure confidentiality of the terms of that agreement. Dr. Berall does not oppose this request, and believes that entry of a Protective Order will facilitate mediation discovery while preserving the legitimate business interests of the parties and other persons. Dr. Berall sent each Defendant a draft Protective Order. Their responses and positions (as Dr. Berall currently understands them) are as follows:

- LMA has agreed to entry of a Stipulated Protective Order limited to mediation.
- Verathon initially indicated agreement on entry of a Stipulated Protective Order, but later rescinded their agreement and now refuses such entry.

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- Pentax of America, Inc. (“Pentax”) initially indicated they would not agree to a Stipulated Protective Order. While Pentax later indicated they would agree to a Stipulated Protective Order, Dr. Berall has heard nothing from Pentax on whether they agreed to the proposed Stipulation, despite repeated e-mails sent to Pentax’s counsel.

Dr. Berall therefore requests an informal conference with the Court regarding entry of a Protective Order. Attached is a proposed Protective Order, solely governing mediation, for the Court’s consideration and discussion at the informal conference.

*Second*, Dr. Berall requests an informal conference with the Court and Verathon regarding discovery that Dr. Berall has requested as part of the mediation process. As detailed in the complaint (D.I. 1), Dr. Berall has alleged that Verathon sold laryngoscopes and displays under the brand name GlideScope that infringe U.S. Pat. No. 5,827,178. Due to the early stay in this case, the parties have not conducted any discovery thus far; therefore, Dr. Berall has no information regarding the sales of this or any other Verathon product line. Verathon has agreed that limited discovery would be useful for mediation, but has denied our request for documents sufficient to identify the volume and amount of GlideScope sales, indicating they do not believe that suite of products infringes the patent. We believe that notwithstanding Verathon’s arguments (with which Dr. Berall disagrees), the limited information being sought by Dr. Berall is reasonable and appropriate in scope. Among other things, such information would assist Dr. Berall in proposing a reasonable settlement offer. After a meet-and-confer and several rounds of correspondence between the parties, we have concluded that Verathon and Dr. Berall are at an impasse on this issue. In a May 15, 2020 letter to Mark Morrill, the parties’ mediator, Dr. Berall requested assistance regarding this dispute, but also that Dr. Berall would seek the Court’s assistance if the parties could not come to an agreement by May 21.

To move the mediation process forward with all Defendants, Dr. Berall therefore respectfully requests an informal conference with the Court. We are available at Your Honor’s convenience.

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Sincerely,



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